



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/706,766	11/12/2003	James D. Ralph	F-296	7793
36402	7590	10/15/2004	EXAMINER	
SPINECORE, INC. 447 SPRINGFIELD AVENUE SUITES W2-W3 SUMMIT, NJ 07901				BLANCO, JAVIER G
		ART UNIT		PAPER NUMBER
		3738		

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/706,766	RALPH ET AL.
	Examiner	Art Unit
	Javier G. Blanco	3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 July 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2 and 5 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,2 and 5 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date .

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____ .

DETAILED ACTION

Response to Amendment

1. Applicants' cancellation of claims 3, 4, 6, and 7 in the reply filed on July 23, 2004 is acknowledged.

Claim Objections

2. Claims 1 and 2 are objected to because of the following informalities:
 - a. Regarding claim 1, please add --plate-- in front of "surfaces" (see lines 6 and 7).
 - b. Regarding claim 2, please add --plate-- in front of "surfaces" (see line 1).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "said ball-shaped head" (see line 3) lacks antecedent basis.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 2, and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 4 of U.S. Patent No. 6,645,249 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1, 2, and 5 of this application and claims 1, 2, and 4 of US 6,645,249 B2 lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 1, 2, and 4 of US 6,645,249 B2 is in effect a “species” of the “generic” invention of claims 1, 2, and 5 of this application. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1, 2, and 5 of the application are anticipated by claims 1, 2, and 4 of US 6,645,249 B2, it is not patentably distinct from claims 1, 2, and 4 of US 6,645,249 B2.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Caenen et al. (FR 2 718 635 A1).

As seen in Figures 4-6 and 10, Caenen et al. disclose an intervertebral spacer device comprising first (character 1) and second (character 2) plate members and at least one multi-pronged domed spring (core 3) disposed between the inner surfaces of plates 1 and 2 (see entire document). Merriam-Webster dictionary defines “pronged” as “*having a usually specified number of prongs*” and “prongs” as “*a slender pointed or projecting part*”. Dictionary.com defines “pronged” as “*having prongs or tines*” or “*resembling a fork; divided or separated into two branches*”. As seen in Figures 4-6 and 10, core 3 contains at least two lateral wings or ribs 16 branching/projecting from core’s body 14.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Marnay et al. (WO 01/01893 A1).

As seen in Figures 1, 3, and 7, Marnay et al. disclose an intervertebral spacer device comprising first (character 2) and second (character 3) plate members and at least one multi-pronged domed spring (“joint employment” 4) disposed between the inner surfaces of plates 2 and 3 (see entire document). Merriam-Webster dictionary defines “pronged” as “*having a usually specified number of prongs*” and “prongs” as “*a slender pointed or projecting part*”. Dictionary.com defines “pronged” as “*having prongs or tines*” or “*resembling a fork; divided or separated into two branches*”. As seen in Figure 1, joint employment 4 (= domed spring) contains at least two guide rails 26 and a rest projection 28 branching/projecting from the spring’s body.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Allain et al. (FR 2 824 261).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB



October 6th, 2004



David H. Willse
Primary Examiner